

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STUART R. KERR III

Appeal No. 1999-2410
Application No. 08/664,462

ON BRIEF

Before WARREN, LIEBERMAN, and KRATZ , Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the refusal of the examiner to allow claims 1 through 22, which are all the claims pending in this application.

THE INVENTION

The invention is directed to a pressure sensitive adhesive tape containing a primer layer and an adhesive layer. The primer layer comprises a cross-linked phenyl-substituted siloxane gum. Additional limitations are provided in the following illustrative claim.

THE CLAIM

Claim 1 is illustrative of appellant's invention and is reproduced below:

1. A pressure sensitive adhesive tape comprising a substrate, a cured primer composition coated onto said substrate in the form of a primer layer, and a pressure sensitive adhesive layer coated onto said cured primer composition,

said cured primer composition comprising a cross-linked phenyl-substituted siloxane gum,

said pressure sensitive adhesive layer comprising a high molecular weight phenyl-substituted, silanol-functional organosiloxane polymer and a silanol-functional resin, said adhesive layer being at least partially cross-linked to said primer layer and securely anchored to said substrate.

THE REFERENCE OF RECORD

As evidence of obviousness, the examiner relies upon the following reference:

Merrill, "Silicone PSA's: Types, Properties, and Uses," Adhesives Age, pages unnumbered (Waterford, NY, Gen. Elec. Co., Mar. 1979).

THE REJECTION

Claims 1 through 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merrill.

OPINION

We have carefully considered all of the arguments advanced by the appellant and the examiner, and agree with the appellant for the reasons set forth in the Brief and below that the rejection of claims 1 through 22 are not well founded. Accordingly, we reverse the

rejection.

The Rejection over Merrill

It is the examiner's position that, "[t]he claimed primer appears to be a conventional phenyl-substituted siloxane gum primer." See Answer page 3. As explained in the Answer, "[t]he Examiner has never asserted that Merrill teaches phenyl silicones as primers. Merrill teaches that methyl silicones act as primers for methyl based silicone psa's. Nevertheless, a person having ordinary skill in the art would have expected phenyl based silicones to function in the same way for phenyl based silicones." See Answer, page 5.

The fallacy in the examiner's logic is that as admitted by the examiner, there is no teaching in Merrill of a primer composition comprising a cross-linked phenyl-substituted siloxane gum as required by the claimed subject matter. Indeed, the examiner has not even found that crosslinked phenyl-substituted siloxane gums are known primers. Stated otherwise, the premise of the examiner assumes a fact not in evidence.

Accordingly, as to the rejection of each of the claims before us, it is well settled that the examiner must show reasons that the skilled artisan with no knowledge of the claimed invention would select the elements from the cited prior art reference in the manner claimed. We determine that there is no reason, suggestion, or motivation to select a

crosslinked phenyl-substituted siloxane gum as a primer based on the teachings of Merrill in the manner proposed by the examiner. Accordingly, the examiner has not established a prima facie case of obviousness and the examiner's rejection under 35 U.S.C. § 103 is not sustained. In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998).

DECISION

The rejection of claims 1 through 22 under 35 U.S.C. § 103(a) as being unpatentable over Merrill is reversed.

The decision of the examiner is reversed.

REVERSED

CHARLES F. WARREN
Administrative Patent Judge

PAUL LIEBERMAN
Administrative Patent Judge

PETER F. KRATZ
Administrative Patent Judge

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